


**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Scott Fergusson et al. Examiner: Linda Krisciunas  
Serial No.: 09/916,951 Group Art Unit: 3623  
Filed: July 27, 2001 Confirmation No.: 9341  
Docket No.: 1137.1103101  
For: METHODS AND SYSTEMS FOR MONITORING THE EFFICACY  
OF A MARKETING PROJECT

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Mail Stop AF  
Assistant Commissioner for Patents  
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<b>CERTIFICATE OF ELECTRONIC TRANSMISSION</b>	
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 Lynn Thompson	April 21, 2006 Date

Applicants submit that the Examiner's rejections contain at least the following clear errors and/or omissions of one or more essential elements needed for a prima facie rejection.

Claims 1-18 and 20-26 are rejected as being anticipated by Melchione et al. (US 5,930,764). Independent claim 1 recites a method in which customized listings of customers are provided that include a listing of the selected customers that the particular representative represents. Applicants submit that this method step is not met by a branch bank being considered a "representative" of a certain group of customers based on geography or type of transaction, as asserted by the Examiner in the Advisory Action. Additionally, this method step is not met by a list of leads being distributed among personal bankers by a branch manager of a branch office, as suggested by Melchione et al. Melchione et al. specifically teach that the branch managers receive a list of leads by a micromarketing center, and assign the leads to the personal bankers most qualified to handle the leads, or based on the workload and availability of the personal bankers. See, for example, Melchione et al., column 9, lines 46-52. This does not appear to have anything to do with providing customized listing of customers that includes a listing of the selected customers that the particular representative represents. As noted above, claim 1 recites a method in which a customized listing of customers is provided to selected representatives and the list includes selected customers that the particular representative represents. Applicants submit

the claimed method step is not met by Melchione et al.

Additionally, Melchione et al. do not appear to teach providing a customer with marketing material from the particular representative who represents him/her. Furthermore, claim 1 recites the method step of "determining which or how many of the customers that were sent the marketing material by their representative actually purchased the product." This step requires determining which or how many of the customers were sent the marketing material, as well as determining which of those customers actually purchased the product. Melchione et al. do not appear to teach tracking which particular customers were contacted, or which of those customers that were actually contacted and provided with marketing material actually purchased the product. Instead, Melchione et al. appear to merely track daily sales information for the bankers. Tracking only daily sales information, as suggested by Melchione et al., would not appear to provide a true indication of the efficacy of the marketing project, because, for example, it may include customers that were contacted but did not receive the marketing materials, and/or customers that were not even contacted by a banker. The Examiner asserts, in the Advisory Action, that when leads are sent out to branches the bankers contact the leads, which *implies* that all customers are contacted and because the system tracks sales, this would constitute tracking those who have been contacted and those who have purchased the product. Applicants submit that a possible implication of all customers being contacted and then tracking only the customers who purchased a product does not anticipate the specific method steps recited in the instant claims. MPEP 2131 states that "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)." Applicants submit that Melchione et al. do not teach method steps in as complete detail as is contained in the instant claims, as is required for anticipation according to MPEP 2131.

Independent claim 10 recites that the marketing material is personalized to at least appear to be from the representative. Nothing in Melchione et al. appears to show this element. The Examiner asserts that Melchione et al. teach a method in which the banker looks up personal information on the customer in order to speak intelligently with the customer during the sales

session, and that this is equivalent to personalizing the marketing material as recited in claim 10. Applicants respectfully disagree. Claim 10 recites the method step of the representatives providing marketing material that is "personalized to at least appear to be from the representative." The instant specification describes such a step as including, for example, formatting the material to be compatible with a merge function such that the representative may create personalized letters, envelopes, emails, and other marketing materials that are then provided to the customer. See specification at, for example, page 15, line 27 through page 16, line 11. Applicants submit that a banker reading electronic information on a potential client prior to meeting with or speaking on the phone with that person is not equivalent to providing marketing material that is personalized to appear to be from a representative, as is recited in independent claim 10.

With respect to dependent claims 20-24, nothing in Melchione et al. appear to teach or suggest providing a customized listing to each representative, and more particularly, a customized listing to each of representative in the recited formats. In fact, since the personal bankers of Melchione et al. do not appear to send out marketing material to customers, but rather simply make phone calls, there is little need to provide a customized listing in a format that is compatible with, for example, printing labels, printing envelopes or post cards, a merge function of an application program, a spreadsheet application program, or an e-mail program.

The Examiner asserts that Melchione et al. teach targeted marketing techniques including direct mailing, telemarketing and computer banking, pointing to column 4, lines 8-37 for support. However, this portion of Melchione et al. is in the background of the invention, where Melchione et al. describes such direct mailing and telemarketing techniques as having the disadvantage of not taking advantage of the information available to full service financial institutions. Melchione et al. thus appear to teach away from such techniques. Additionally, Applicants submit that the mere fact that Melchione et al. suggest "the system includes means for downloading reports and files to local printers or storage devices" (column 8, lines 49-50) does not anticipate the specific steps recited in claims 20-24.

In the Advisory Action, the Examiner has, for the first time, addressed claim 25, which was amended in the response filed December 29, 2005. The Examiner asserts that Melchione et al.'s teaching of the bank management deciding on a sales promotion and communicating it to the regional marketing center which in turn informs the branches and personal bankers anticipates the claimed step of providing a notice announcing a marketing project to the representatives. Melchione et al., however, actually teach the bank management deciding on a sales promotion and that the "sales promotion concept is communicated to the regional micromarketing center. The system allows the regional micromarketing center to use the user work station to generate leads." See column 7, lines 13-22. Melchione et al. teach the personal bankers using the leads for making sales calls. Melchione et al. thus teach providing leads to the bank representatives, and does not appear to teach providing a notice announcing a marketing project to representatives. The Examiner then asserts that because Melchione et al.'s system provides detailed access to the sales transactions for each banker and one can view sales results for various campaigns to track the performance, this is equivalent to the claimed marketing project appeal indicator because it performs an identical function in substantially the same manner with substantially the same results. Applicants respectfully disagree. As stated above, MPEP 2131 requires a reference to teach the invention in the same detail as it is claimed for the reference to be anticipatory. Melchione et al. do not teach the claimed method steps and the Examiner's assertion that one could use the information gathered by Melchione et al. to perform the claimed method is an improper basis for an anticipation rejection.

In the Advisory Action, the Examiner has, for the first time, addressed Applicants' challenge of the Official Notice that was asserted in the office action mailed September 30, 2005. The Examiner took Official Notice with respect to claims 14 and 18, asserting that the concept and advantages of determining common characteristics for customers that purchased or did not purchase the product are well known and expected in the art. The Examiner has now provided references asserted to teach the elements missing from Melchione et al. Applicants submit that as the additional references appear to be cited for teaching elements of the claims, the anticipation rejection based solely on Melchione et al. is improper. Further, in the rejection, the

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Examiner states that "[i]t would have been obvious to conduct research on customers to better understand their motivation for purchasing the product." Emphasis added; see end of page 8 of the Office Action mailed January 24, 2006. For these and other reasons, the anticipation rejection of at least claims 14 and 18 appears to be improper in view of the asserted obviousness basis of the rejection.

Claims 19 and 31-35 are rejected as being unpatentable over Melchione et al. in view of 17 CFR Part 24. 17 CFR Part 24 does not appear to provide what Melchione et al. lack. Thus, even if one were to combine Melchione et al. and 17 CFR Part 24, one would not arrive at the claimed invention. Additionally, there does not appear to be any motivation for combining the teachings of Melchione et al. and 17 CFR Part 24. Applicants submit that the mere presence of regulations relating to consumer privacy does not provide any motivation, guidance or suggestion for one of ordinary skill in the art to modify the method of Melchione et al. to achieve the claimed method. This rejection was originally presented in the Office Action of September 30, 2005, and Applicants presented arguments in the response filed December 29, 2005. The Examiner has not yet responded to Applicants' arguments regarding this rejection. In the Office Action mailed January 24, 2006, the Examiner merely restated the rejection. Regarding claims 31-35, the Examiner asserts that Melchione et al. teach providing compliant marketing material and a customized listing of the selected customers to at least some of the representatives, pointing to column 9, lines 44-52 for support. Applicants have reviewed this passage in Melchione et al., as well as the remainder of the document, and have found no such teaching. Melchione et al. do not appear to teach anything regarding checking marketing material for compliance with applicable rules and regulations.

  
Respectfully submitted,

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